THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JOHN T. LAVIN

Appeal No. 97-4429
Application No. 08/404,666[1]

ON BRIEF

Before COHEN, McQUADE, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 12 through 21, which are all of the claims pending in this application. On page 2 of the brief, the appellant states that the rejection of claims 14 and 18 is not being appealed. Consequently, the appeal is dismissed with respect to claims 14 and 18. Claims 12, 13, 15 through 17 and 19 through 21 remain on appeal.

[1] Application for patent filed March 15, 1995.

We REVERSE.

BACKGROUND

The appellant's invention relates to an air separation plant. An understanding of the invention can be derived from a reading of exemplary claims 12 and 17, which appear in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Smith	3,127,260	Mar. 31, 1964
Sunder et al. (Sunder)	5,122,174	June 16, 1992
Collin et al. (Collin)	5,316,628	May 31, 1994

Claims 12, 13, 15 and 17, 19 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Collin in view of Smith.

Claims 16 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Collin in view of Smith and Sunder.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 13, mailed July 3, 1997) for the examiner's complete reasoning in

support of the rejections, and to the appellant's brief (Paper No. 12, filed April 2, 1997) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

With regard to the 35 U.S.C. § 103 rejection of independent claims 12 and 17 as being unpatentable over Collin in view of Smith, the examiner concluded (answer, pp. 5-6) that it would have been obvious to one of ordinary skill in the art to employ the "condenser/reboiler heat exchanger" of Collin as the "condenser/reboiler heat exchanger" of Smith (i.e., Smith's condensers 20, 22) in the air separation system of Smith. We do not agree.

The teachings of Smith and Collin are set forth on pages 4-5 of the answer.

It is axiomatic that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting such combination. See In re Bond, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

We agree with the appellant that the applied prior art fails to provide the needed suggestion or motivation to one of ordinary skill in the art at the time of the appellant's invention to modify the applied prior art as proposed by the examiner. That is, we agree that the combined teachings of the applied prior art would not have resulted in the substitution of Collin's device for the condensers 20, 22 of Smith. In fact, the examiner relies on condenser 20 of Smith to be the subcooler recited in claim 1 and to perform the subcooling step recited in claim 17. Furthermore, we see no suggestion or motivation, absent impermissible hindsight, to substitute Collin's device for the condenser 22 of Smith. Accordingly, we will not sustain the 35 U.S.C. § 103 rejection of claims 12, 13, 15, 17, 19 and 20.

We have also reviewed the Sunder reference additionally applied in the rejection of claims 16 and 21 but find nothing therein which makes up for the deficiencies of Collin and Smith discussed above. Accordingly, we cannot sustain the examiner's rejection of appealed claims 16 and 21 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 12, 13, 15 through 17 and 19 through 21 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN Administrative Patent Judge	)
JOHN P. McQUADE Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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APPEAL NO. 97-4429 - JUDGE NASE
APPLICATION NO. 08/404,666

APJ NASE

APJ McQUADE

APJ COHEN

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 14 Jul 98

FINAL TYPED: